

Remarks

This application has been reviewed in light of the Office Action of August 18, 2006. Claims 1-24 are pending, and all claims are rejected. In this paper, claim 23 is amended and the following remarks are submitted. Reconsideration of this application is respectfully requested.

**Ground 1.** Claims 1, 7, 13, 23, and 24 are provisionally rejected on the ground of obviousness-type double patenting as unpatentable over claims 1 and 9 of SN 10/802,801 in view of Duchane U.S. Patent 4,481,999. Applicant traverses this ground of rejection.

MPEP 804 discusses the basis for the obviousness-type double patenting rejection. As set forth there,

"In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is--does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent? If the answer is yes, then an 'obviousness-type' nonstatutory double patenting rejection may be appropriate. Obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. [citations omitted]

"A double patenting rejection of the obviousness-type is analogous to [a failure to meet] the nonobviousness requirement of 35 USC 103' except that the patent principally underlying the double patenting rejection is not considered prior art. [citation omitted] Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 USC 103 obviousness determination. [citations omitted]."

Following the analytical approach mandated by the last paragraph of the quotation, MPEP 2142, under ESTABLISHING A PRIMA FACIE CASE OF OBVIOUSNESS, provides: "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. [citations omitted]. See MPEP para 2143-2143.03 for decisions pertinent to each of these criteria."

First requirement--there must be an objective  
basis for combining the teachings of the references

The first of the requirements of MPEP 2142 is that "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings." The present rejection is a sec. 103 combination rejection. To reach a proper teaching of an article or process through a combination of references, there must be stated an objective motivation to combine the teachings of the references, not a hindsight rationalization in light of the disclosure of the specification being examined. MPEP 2142, 2143 and 2143.01. See also, for example, In re Fine, 5 USPQ2d 1596, 1598 (at headnote 1) (Fed. Cir. 1988), In re Laskowski, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989), W.L. Gore & Associates v. Garlock, Inc., 220 USPQ 303, 311-3 13 (Fed. Cir., 1983), and Ex parte Levengood, 28 IJSPQ2d 1300 (Board of Appeals and Interferences, 1993); Ex parte Chicago Rawhide Manufacturing Co., 223 USPQ 351 (Board of Appeals 1984). As stated in In re Fine at 5 USPQ2d 1598:

"The PTO has the burden under section 103 to establish a prima facie case of obviousness. [citation omitted] It can satisfy this burden only by showing

some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

And, at 5 USPQ2d 1600:

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

Following this authority, the MPEP states that the examiner must provide such an objective basis for combining the teachings of the applied prior art. In constructing such rejections, MPEP 2143.01 provides specific instructions as to what must be shown in order to extract specific teachings from the individual references:

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention when there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)."

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"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)."

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"A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some

objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd.Pat.App. & Inter. 1993)."

Here, there is set forth no objective basis for combining the teachings of the references in the manner used by this rejection, and selecting the helpful portions from each reference while ignoring the unhelpful portions. An objective basis is one set forth in the art or which can be established by a declaration, not one that can be developed in light of the present disclosure. In this case, the explanation of the rejection does not address this requirement, as there is no attempt to state an objective basis for combining the teachings of the two references. If the rejection is maintained, Applicant asks that the Examiner set forth the objective basis found in the references themselves for combining the teachings of the references, and for adopting only the helpful teachings of each reference and disregarding the unhelpful teachings of the reference. Thus, as it stands now, the invention as a whole is not *prima facie* obvious over the combined teachings of the prior art.

Second requirement--there must be  
an expectation of success

The second of the requirements of MPEP 2142 is an expectation of success. This requirement has not been addressed in the explanation of the rejection, and in any event more than Examiner's argument is required here.

As stated in MPEP 2142, "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. [citations omitted]."

Third requirement--the prior art  
must teach the claim limitations

The third of the requirements of MPEP 2142 is that "the prior art reference (or references when combined) must teach or suggest all the claim limitations." In this regard,

the following principle of law applies to all sec. 103 rejections. MPEP 2143.03 provides "To establish prima facie obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." [emphasis added] That is, to have any expectation of rejecting the claims over a single reference or a combination of references, each limitation must be taught somewhere in the applied prior art. If limitations are not found in any of the applied prior art, the rejection cannot stand. In this case, the applied prior art references clearly do not arguably teach some limitations of the claims.

There are numerous limitation of the claims that are not taught by the references.  
The present claim 1 recites in part:

"applying a first release system..."  
"applying a second release system..."

Neither the claims of SN 10/702,801 nor Duchane teach this limitation, and the explanation of the rejection does not suggest that they do. SN 10/702,801 speaks only of a release system, not two release systems. If this rejection is maintained, Applicant asks that the Examiner point out precisely where this limitation is said to be taught in the claims of SN 10/702,801 or Duchane.

Claim 1 further recites in part:

"the first release system is dissolvable in a first-release-coating solvent that does not dissolve the second release system;"

Neither the claims of SN 10/702,801 nor Duchane teach this limitation, and the explanation of the rejection does not suggest that they do. Neither reference suggests a first release system that is dissolvable in a solvent that does not dissolve the second release system. If this rejection is maintained, Applicant asks that the Examiner point out

precisely where this limitation is said to be taught in the claims of SN 10/702,801 or Duchane.

Claim 7 incorporates the limitations of claim 1, and further recites:

"applying the second release system to the second face of the optical coating, wherein the second release system has a first face contacting the second face of the optical coating, and a second face remote from the first face..."

Neither reference has such a teaching of a second release system applied to the second face of the optical coating and the additional limitations quoted above.

Regarding the present claims 23 and 24, claim 1 of SN 10/702,801 teaches:

"furnishing the metallic article..."

That is, claim 1 of SN 10/702,801 teaches that the article must be metallic. The present claims 23-24 do not recite that the article is metallic.

The statement found in the last two lines of page 2 of the Office Action is thus not correct: "..claims 23 and 24 of the instant application are anticipated by claim 1 of the copending application."

Claim 23 further recites in part:

"the method utilizes two different release systems to accomplish the step of transferring"

Claim 23 recites two different release systems. The claims of 10/702,801 have no teaching of two different release systems, nor does Duchane. The explanation of the rejection does not address this limitation. If the rejection is maintained. Applicant asks that the Examiner indicate the asserted location of the disclosure of this limitation in Ross.

Applicant asks that the Examiner reconsider and withdraw this ground of rejection.

Ground 2. Claims 1, 4-9, 15, 23, and 24 are rejected under 35 USC 102 as anticipated by Ross U.S. Patent 5,830,529. Applicant traverses this ground of rejection.

The following principle of law applies to sec. 102 rejections. MPEP 2131 provides: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the ... claim. The elements must be arranged as required by the claim..." [citations omitted] This is in accord with the decisions of the courts. Anticipation under section 102 requires 'the presence in a single prior art disclosure of all elements of a claimed invention arranged as in that claim.' Carella v. Starlight Archery, 231 USPQ 644, 646 (Fed. Cir., 1986), quoting Panduit Corporation v. Dennison Manufacturing Corp., 227 USPQ 337, 350 (Fed. Cir., 1985).

Thus, identifying a single element of the claim, which is not disclosed in the reference, is sufficient to overcome a Sec. 102 rejection.

Claim 1 recites in part:

"applying a first release system to the deposition substrate;  
"applying a second release system and a transfer substrate to the  
second face of the optical coating..."

Claim 1 recites two different release systems. Ross has no disclosure of "a first release system" and "a second release system." The explanation of the rejection does not address this limitation. If the rejection is maintained, Applicant asks that the Examiner indicate the asserted location of the disclosure of this limitation in Ross.

Claim 1 further recites in part:

"the first release system is dissolvable in a first-release-coating solvent that  
does not dissolve the second release system;"

Ross has no disclosure that a first release system is dissolvable in a first-release-coating solvent that does not dissolve a second release system. If the rejection is maintained, Applicant asks that the Examiner indicate the asserted location of the disclosure of this limitation in Ross.

Claim 23 recites in part:

"the method utilizes two different release systems to accomplish the step of transferring"

Claim 23 recites two different release systems. Ross has no disclosure of two different release systems. The explanation of the rejection does not address this limitation. If the rejection is maintained, Applicant asks that the Examiner indicate the asserted location of the disclosure of this limitation in Ross.

Applicant asks that the Examiner reconsider and withdraw this ground of rejection.

**Ground 3.** Claim 2 is rejected under 35 USC 103 over Ross '529 in view of Duchane '999. Applicant traverses this ground of rejection.

Claim 2 depends from claim 1 and incorporates its limitations. The limitations of claim 1 are not taught by Ross '529 for the reasons stated in relation to the prior rejections, which discussion is incorporated here. Duchane adds nothing in this regard. Claim 1 is patentable over this ground of rejection, and claim 2 is patentable as well.

The discussion of the three requirements for the sec. 103 rejection is incorporated from the Ground 1 rejection.

First requirement--there must be an objective  
basis for combining the teachings of the references

The two references teach quite different approaches. Ross teaches a transfer approach, while Duchane teaches that the deposited metal film is to stay on the same support structure upon which it was initially deposited (the polyvinyl film is dissolved).

There is no guidance in the references as to how to combine the teachings, and how to resolve the different approaches and different results. The explanation of the rejection (Office Action, page 6, lines 7-11) discusses two of the objectives of Duchane, but these are merely objectives of Duchane and not objective reasons to combine the teachings of Duchane with the different teachings of Ross. Duchane's objectives are possibly fulfilled with Duchane's approach, but not with those of Ross. If the teachings of Duchane are to be combined with those of Ross, some objective basis for reconciling the different approaches must be provided.

The explanation of the rejection does not explain how these two different approaches are to be used together. That is, there is no objective basis stated for combining the teachings of the references.

If the rejection is maintained, Applicant asks that the Examiner indicate the objective basis for combining the teachings of these two completely different approaches.

Second requirement--there must be  
an expectation of success

The explanation of the rejection does not mention this requirement. It is highly unlikely that there could be an expectation of success in combining the teachings of two references with entirely different approaches. However, if there is one, Applicant requests that it be set forth in the next Office Action.

Third requirement--the prior art  
must teach the claim limitations

Claim 2 recites in part:

"the step of providing a deposition substrate includes the step of  
providing an organic deposition substrate."

In the reconstruction proposed in the explanation of the rejection (Office Action, page 2, lines 1-11), the polyvinyl alcohol is analogized to the recited "deposition substrate."

However, claim 1 recites in part:

"providing a deposition substrate; thereafter  
applying a first release system to the deposition substrate..."

In Duchane, the polyvinyl alcohol is the release system for the supporting structure, because the polyvinyl alcohol is dissolved as part of the processing. Thus, to identify the polyvinyl alcohol as the organic deposition substrate is not correct, because it cannot be both the deposition substrate and the release system.

**Ground 4.** Claim 3 is rejected under 35 USC 103 as unpatentable over Ross '529 in view of Shaul U.S. Patent 3,925,138. Applicant traverses this ground of rejection.

Claim 3 depends from claim 1 and incorporates its limitations. The limitations of claim 1 are not taught by Ross '529 for the reasons stated in relation to the prior rejections, which discussion is incorporated here. Shaul adds nothing in this regard. Claim 1 is patentable over this ground of rejection, and claim 3 is patentable as well.

The discussion of the three requirements for the sec. 103 rejection is incorporated from the Ground 1 rejection.

First requirement--there must be an objective  
basis for combining the teachings of the references

Ross deals with release materials, but Shaul does not. As discussed at page 6, lines 15-22 of the Office Action, Shaul does use aluminum as a carrier and dissolves the carrier. But the aluminum does not appear to be serving as a release material. In the example referenced in the explanation of the rejection, col. 7. lines 18-23 of Shaul, the aluminum is the surface layer. The aluminum surface layer is then etched away, in preparation for later depositing another layer on the surface of the substrate. In this

application, the aluminum does not serve as a release material whose removal releases an attached structure or causes release from an attached structure. Thus, there is no reason to use this approach in conjunction with the approach of Ross, as Ross has no need for a surface layer of aluminum to be etched away.

Second requirement--there must be  
an expectation of success

This requirement is not addressed in the explanation of the rejection. For the reasons just stated, Applicant cannot see how the use of the aluminum surface layer of Shaul would lead to an expectation of success in the approach of Ross.

Third requirement--the prior art  
must teach the claim limitations

Claim 3 further recites in part:

"the step of applying a first release system includes the step of  
applying an aluminum layer as the first release system"

In the example referenced in the explanation of the rejection, col. 7, lines 18-23 of Shaul, the aluminum is the surface layer. The aluminum surface layer is then etched away, in preparation for later depositing another layer on the surface of the substrate. In this application, the aluminum does not serve as a release material whose removal releases an attached structure or causes release from an attached structure. The aluminum in Shaul's technology is more properly described as a carrier material for woven glass sheets (Shaul, col. 7, lines 11-14), not as a release layer.

**Ground 5.** Claims 10-12 are rejected under 35 USC 103 over Ross '529 and further in view of Conolly U.S. Patent 4,623,087. Applicant traverses this ground of rejection.

Claims 10-12 depend from claim 1 and incorporates its limitations. The limitations of claim 1 are not taught by Ross '529 for the reasons stated in relation to the prior rejections, which discussion is incorporated here. Conolly adds nothing in this regard. Claim 1 is patentable over this ground of rejection, and claims 10-12 are patentable as well.

The discussion of the three requirements for the sec. 103 rejection is incorporated from the Ground 1 rejection.

First requirement--there must be an objective basis for combining the teachings of the references

Ross is used in this rejection because it is said to use a release system. Conolly explicitly states that it uses a carrier member (col. 1, line 34; col. 2, line 15; col. 4, line 43). That is an entirely different approach from a release member, and there is no reasoning given as to how these two approaches might be used together. The explanation of the rejection at page 7, lines 8-11 and 16-18 that it would be obvious to use the carrier-member approach of Conolly instead of the approach of Ross, but that is not a basis for combining the teachings of these two references that teach entirely different approaches. If the rejection is maintained, Applicant asks for the indication an objective basis for combining the two references, and for rationalizing the use of the different approaches.

Second requirement--there must be an expectation of success

This requirement is not addressed in the explanation of the rejection. For the reasons just stated, Applicant cannot see how the use of the carrier-member approach of Conolly would lead to an expectation of success in the release-layer approach of Ross.

Third requirement--the prior art must teach the claim limitations

Claim 10 further recites in part:

"the step of furnishing the article includes the step of  
furnishing the article that is a component of a gas turbine engine"

Conolly is relied upon for this teaching, but if the approach of Conolly is relied upon, then the carrier-member approach of Conolly must be adopted as well. In that case, there is no teaching of using a release system as recited in claim 1.

Claim 11 further recites in part:

"the step of furnishing the article includes the step of  
furnishing a new-make article."

Claim 12 further recites in part:

"the step of furnishing the article includes the step of  
furnishing an article which has previously been in service."

The explanation of the rejection recognizes that neither Ross nor Conolly teaches these limitations (Office Action, page 7, lines 12-13). The argument that follows appears to say that while Conolly does not teach these limitations, they are somehow still found in Conolly. As noted earlier, MPEP 2142 requires that "the prior art reference (or references when combined) must teach or suggest all the claim limitations." In this case, it is clear from the admission of the explanation of the rejection that Conolly does not teach the limitations of claims 11 and 12.

**Ground 6.** Claims 13, 16-18, and 20 are rejected under 35 USC 103 over Ross '529 and further in view of Hankland U.S. Patent 4,407,685. Applicant traverses this ground of rejection.

Claims 13, 16-18, and 20 depend from claim 1 and incorporates its limitations. The limitations of claim 1 are not taught by Ross '529 for the reasons stated in relation to the prior rejections which discussion is incorporated here. Hankland adds nothing in this regard. Claim 1 is patentable over this ground of rejection, and claims 13, 16-18, and 20 are patentable as well.

The discussion of the three requirements for the sec. 103 rejection is incorporated from the Ground 1 rejection.

First requirement--there must be an objective  
basis for combining the teachings of the references

Ross is relied upon because it is said to teach the release system approach recited in claim 1. This process requires placing release materials between surfaces and then dissolving the release material. Hankland uses an entirely different approach. Hankland coats a stretchable film with a thin layer of metal. The stretchable film is stretched over a composite object, with the thin layer of metal between the stretchable film and the composite object. The stretchable film is then peeled away. (See Abstract, claim 1). The stretchable film is not located between the metal layer and the composite object, as Ross is said to teach and is recited in the present claim 1.

The explanation of the rejection does not explain how these two different approaches are to be used together. That is, there is no objective basis stated for combining the teachings of the references.

If the rejection is maintained, Applicant asks that the Examiner indicate the objective basis for combining the teachings of these two completely different approaches.

Second requirement--there must be  
an expectation of success

This requirement is not addressed in the explanation of the rejection. For the reasons just stated, Applicant cannot see how the approach of Hankland would lead to an expectation of success when used with the approach of Ross.

Third requirement--the prior art  
must teach the claim limitations

Claim 13 recites in part:

"the step of affixing the first face includes the step of  
positioning a bonding element between the first face of the optical  
coating and the article surface, and  
pressing the bonding element, the first face, and the article surface  
together at an elevated temperature."

The "first face" as recited in claim 13 is identified in claim 1:

"...the optical coating has a first face contacting the first release  
system, and a second face remote from the first face..."

That is, the "first face" previously had a first release system applied to it prior to the step of affixing.

Neither of the references teaches that a "first face", which previously had a first release system applied thereto, then has a bonding element positioned between it and the article surface. The explanation of the rejection does not address this limitation. If the rejection is maintained, Applicant asks that the Examiner point out the sequence of events in either reference where such a series of steps is said to occur.

Claim 16 recites in part:

"the step of affixing the first face includes the step of  
heating and pressing the first face using an autoclave"

The "first face" is as described above in relation to claim 13. Neither reference teaches that a "first face", which previously had a first release system applied thereto, is heated and pressed using an autoclave. The explanation of the rejection does not address

this limitation. If the rejection is maintained, Applicant asks that the Examiner point out the sequence of events in either reference where such a series of steps is said to occur.

Claim 17 recites in part:

"the step of affixing the first face includes the step of  
heating and pressing the first face using a vacuum bag and a general  
heat source"

The "first face" is as described above in relation to claim 13. Neither reference teaches that a "first face", which previously had a first release system, applied thereto, is heated and pressed using a vacuum bag and a general heat source. The explanation of the rejection does not address this limitation. If the rejection is maintained, Applicant asks that the Examiner point out the sequence of events in either reference where such a series of steps is said to occur.

Claim 18 recites in part:

"the step of affixing the first face includes the step of  
heating and pressing the first face using a vacuum bag and a local  
heat source"

The "first face" is as described above in relation to claim 13. Neither reference teaches that a "first face", which previously had a first release system, applied thereto, is heated and pressed using a vacuum bag and a local heat source. The explanation of the rejection does not address this limitation. If the rejection is maintained, Applicant asks that the Examiner point out the sequence of events in either reference where such a series of steps is said to occur.

Claim 20 recites in part:

"preparing the transfer substrate and optical coating as a plurality of tiles that  
are each affixed to the article surface in the step of affixing"

Neither reference has such a teaching. The explanation of the rejection does not address this limitation. If the rejection is maintained, Applicant asks that the Examiner point out the sequence of events in either reference where such a series of steps is said to occur.

**Ground 7.** Claim 19 is rejected under 35 USC 103 as unpatentable over Ross '529 in view of Alexander U.S. patent 3,654,016. Applicant traverses this ground of rejection.

Claim 19 depends from claim 1 and incorporates its limitations. The limitations of claim 1 are not taught by Ross '529 for the reasons stated in relation to the prior rejections, which discussion is incorporated here. Alexander adds nothing in this regard. Claim 1 is patentable over this ground of rejection, and claim 19 is patentable as well.

The discussion of the three requirements for the sec. 103 rejection is incorporated from the Ground 1 rejection.

First requirement--there must be an objective  
basis for combining the teachings of the references

While Ross deals with the subject of release-based approaches, Alexander does not. As the explanation of the rejection points out (Office Action, page 8, lines 13-16), Alexander teaches an approach based on a carrier member. If a combination of the teachings is to be made adopting specific ironing teachings from Alexander, the resulting approach would use a carrier member as in Alexander, not a release system as in Ross. There is no basis for otherwise combining the disparate teachings of these two entirely different approaches. The explanation of the rejection argues that the rationale is "greatly reduced waste" (Office Action, page 8, lines 19-20), but that advantage asserted for Alexander relates only to ironing approaches, not to the release approach claimed for Ross and for the present approach. If the rejection is maintained, Applicant asks for the indication of an objective basis for combining the two references, and for rationalizing the use of the different approaches.

Second requirement--there must be  
an expectation of success

This requirement is not addressed in the explanation of the rejection. For the reasons just stated, Applicant cannot see how the approach of Alexander would lead to an expectation of success when used with the approach of Ross.

Third requirement--the prior art  
must teach the claim limitations

Claim 19 recites in part:

"the step of affixing the first face includes the step of  
ironing the first face onto the article surface."

As discussed in relation to the rejection of claim 13 under Ground 6, which discussion is incorporated here, the "first face" referenced in claim 19 is the face that previously had a release system applied to it, which release system was later removed prior to the step of affixing. The face of the material that is being ironed in Alexander never had a release system applied to it, as far as Applicant can tell. If the rejection is maintained, Applicant asks that the Examiner indicate the teaching in Alexander of a release system applied to the "first face."

**Ground 8.** Claim 14 is rejected under 35 USC 103 as unpatentable over Ross '529 in view of Oliva U.S. patent 4,153,494. Applicant traverses this ground of rejection.

Claim 14 depends from claim 1 and incorporates its limitations. The limitations of claim 1 are not taught by Ross '529 for the reasons stated in relation to the prior rejections, which discussion is incorporated here. Oliva adds nothing in this regard. Claim 1 is patentable over this ground of rejection, and claim 14 is patentable as well.

The discussion of the three requirements for the sec. 103 rejection is incorporated from the Ground 1 rejection.

First requirement--there must be an objective basis for combining the teachings of the references

Oliva teaches that an adhesive or varnish is applied to a surface or to one side of a plastic sheet, and then a metallic dust is adhered to the plastic sheet and placed in contact with the surface. The metallic dust is embedded in the adhesive or varnish and thus adheres to the surface after the adhesive or varnish hardens. There is no coating of the metallic dust.

The approach of Oliva is inconsistent with that of the proposed approach of Ross. Oliva does not use both a deposition substrate and a transfer support, as required by the present claims and as attempted to be simulated by the teachings of Ross. Taking the plastic sheet of Oliva to be a deposition support, because the metallic dust is deposited on this plastic sheet, then Oliva has no transfer support. If the teachings of Oliva are to be combined with those of Ross, then this combined teachings of the three references has no transfer support. The result is that the limitations of claim 1, which are incorporated into the interpretation of claim 14, are not met by the combination of the three references: there is no transfer support as recited in claim 1. If it is argued that the teachings are modified so as to again insert a transfer support, that is a *per se* hindsight reconstruction. If the rejection is maintained, Applicant asks for the indication an objective basis for combining the two references, and for rationalizing the use of the different approaches.

Second requirement--there must be an expectation of success

This requirement is not addressed in the explanation of the rejection. For the reasons just stated, Applicant cannot see how the approach of Oliva would lead to an expectation of success when used with the approach of Ross.

Third requirement--the prior art  
must teach the claim limitations

Claim 14 recites in part:

"...the step of affixing the first face includes the step of  
bonding a bonding element to the article surface, and thereafter  
bonding the first face of the optical coating to the bonding element."

Applicant agrees with the explanation of the rejection that Ross does not teach this limitation.

As discussed in relation to the rejection of claim 13 under Ground 6, which discussion is incorporated here, the "first face" referenced in claim 14 is the face that previously had a release system applied to it, which release system was later removed prior to the step of affixing. The face of the material in Oliva never had a release system applied to it, as far as Applicant can tell. If the rejection is maintained, Applicant asks that the Examiner indicate the teaching in Oliva of a release system applied to the "first face."

Further, Oliva does not teach an optical coating. Oliva teaches metallic dust that is embedded into the varnish or adhesive on the surface. In one embodiment, Oliva applies the varnish or adhesive to the surface of the article, and then, prior to bonding the varnish to the surface, adds the metallic dust into the wet varnish (Oliva, col. 2, lines 29-41). The combination of the three references does not teach the limitation "bonding the bonding element to the article surface, and thereafter bonding the optical coating to the bonding element." In fact, as discussed at col. 2, lines 29-41, the two steps must be performed simultaneously.

In the other embodiment of Oliva (col. 2, lines 42-51), the varnish is applied to the face of a plastic sheet which already has metallic dust adhered thereto. Before the varnish hardens, the plastic sheet is pressed against the article surface and held in place until the varnish hardens. Again, the bonding of the metallic dust to the varnish occurs simultaneously with the bonding of the varnish to the article surface. The combination of the three references does not teach the limitation "bonding the bonding element to the

article surface, and thereafter bonding the optical coating to the bonding element," because the two bondings occur simultaneously.

**Ground 9.** Claims 21 and 22 are rejected under 35 USC 103 over Ross '529 in view of Duchane '999 and Hankland '685.

The discussion of the three requirements for the sec. 103 rejection is incorporated from the Ground 1 rejection.

**Claim 21**

First requirement--there must be an objective basis for combining the teachings of the references

Ross and Duchane teach quite different approaches. Ross teaches a transfer approach, while Duchane teaches that the deposited metal film is to stay on the same support structure upon which it was initially deposited (the polyvinyl film is dissolved). There is no guidance in the references as to how to combine the teachings, and how to resolve the different approaches and different results. The explanation of the rejection (Office Action, page 6, lines 7-11) discusses two of the objectives of Duchane, but these are merely objectives of Duchane and not objective reasons to combine the teachings of Duchane with the different teachings of Ross. Duchane's objectives are possibly fulfilled with Duchane's approach, but not with those of Ross.

The explanation of the rejection does not explain how these two different approaches are to be used together. That is, there is no objective basis stated for combining the teachings of the references.

If the rejection is maintained, Applicant asks that the Examiner indicate the objective basis for combining the teachings of these two completely different approaches.

Ross is relied upon because it is said to teach the release system approach recited in claim 1. This process requires placing release materials between surfaces and then dissolving the release material. Hankland uses an entirely different approach. Hankland

coats a stretchable film with a thin layer of metal. The stretchable film is stretched over a composite object, with the thin layer of metal between the stretchable film and the composite object. The stretchable film is then peeled away. (See Abstract, claim 1). The stretchable film is not located between the metal layer and the composite object, as Ross is said to teach and is recited in the present claim 1.

The explanation of the rejection does not explain how these two different approaches are to be used together. That is, there is no objective basis stated for combining the teachings of the references.

If the rejection is maintained, Applicant asks that the Examiner indicate the objective basis for combining the teachings of these two completely different approaches.

Second requirement--there must be  
an expectation of success

This requirement is not addressed in the explanation of the rejection. For the reasons just stated, Applicant cannot see how the approaches of Duchane and Hankland would lead to an expectation of success when used with the approach of Ross.

Third requirement--the prior art  
must teach the claim limitations

Claim 21 recites in part:

applying a first release system to the deposition substrate; thereafter  
depositing the optical coating onto the deposition substrate, with the  
first release system between the optical coating and the deposition substrate,  
wherein the optical coating has a first face contacting the first release system,  
and a second face remote from the first face; thereafter  
providing a release-and-transfer structure having a second release  
system integrated with a transfer substrate; thereafter. [emphasis added]

Claim 21 recites two different release systems. None of the references has any teaching of "a first release system" and "a second release system." The explanation of the rejection does not address this limitation. If the rejection is maintained, Applicant asks that the Examiner indicate the asserted location of the disclosure of this limitation in any of the references.

Claim 21 further recites in part:

"the first release system is dissolvable in a first-release-coating solvent that does not dissolve the release-and-transfer structure"

None of the references has any teaching that a first release system is dissolvable in a first-release-coating solvent that does not dissolve a release-and-transfer structure. If the rejection is maintained, Applicant asks that the Examiner indicate the asserted location of the teaching of this limitation in any of the references.

Claim 21 further recites in part:

"the step of affixing including the steps of  
positioning a bonding element between the first face of the optical coating and the article surface, and  
pressing the bonding element, the first face, and the article surface together at an elevated temperature."

As discussed in relation to the rejection of claim 13 under Ground 6, which discussion is incorporated here, the "first face" referenced in claim 21 is the face that previously had a release system applied to it, which release system was later removed prior to the step of affixing. The materials in the references never had a release system applied to them, as far as Applicant can tell. If the rejection is maintained, Applicant asks that the Examiner indicate the teaching in the references of a release system applied to the "first face", which was thereafter processed as recited in the above excerpt.

Claim 22

Claim 22 depends from claim 21 and incorporates its limitations. The limitations of claim 21 are not taught by the references for the reasons stated in relation to the prior rejections, which discussion is incorporated here. Claim 21 is patentable over this ground of rejection, and claim 22 is patentable as well.

The discussion of the first and second requirements for the sec. 103 rejections is incorporated from the above discussion of claim 21.

Third requirement--the prior art  
must teach the claim limitations

Claim 22 recites in part:

"the step of applying a second release system and transfer substrate includes  
the step of  
providing the release-and-transfer structure as a polymeric releasable  
adhesive tape."

As noted earlier in relation to the rejections of claims 1 and 21, none of the references teaches "a second release system", and accordingly there is no step of "applying a second release system..." Nor do the references teach a "release-and-transfer structure," and therefore the references cannot teach this limitation.

Applicant asks that the Examiner reconsider and withdraw the various grounds of rejections, and issue the application.

**CONCLUSION**

For at least the reasons set forth above, Applicant respectfully requests reconsideration of the Application and withdrawal of all outstanding rejections. Applicant respectfully submits that the claims are not anticipated by, nor rendered obvious in view of; the cited art either alone or in combination and thus, are in condition for allowance. Thus, Applicant requests allowance of all pending claims in a timely manner.

This Response has been filed within three (3) months of the mailing date of the Office Action and it is believed that no fees are due with the filing of this paper. In the event that Applicant is mistaken in these calculations, the Commissioner is hereby authorized to deduct any fees determined by the Patent Office to be due from the undersigned's Deposit Account No. 50-1059.

Respectfully submitted,

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